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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,792	07/21/2003	Thomas J. Burke	660041-2002.1	6106

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NEW YORK, NY 10151

EXAMINER

REDMAN, JERRY E

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,792

Applicant(s)

BURKE, THOMAS J.

Examiner

Jerry Redman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/21/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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Applicant's election without traverse of Group IV in the reply filed on 12/27/2004 is acknowledged. Currently, claims 1-20 read on the elected invention.

The applicant's information disclosure statement dated 7/21/2003 has been considered and a copy has been placed in the file.

Claims 4-7 and 13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 4, line 2, claim 7, line 2, claim 13, line 2, claim 16, line 2, claim 17, line 2, and claim 18, line 2, the phraseology "and/or" is indefinite and fails to clearly and positively recite the applicant's claimed invention.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 10-20 are rejected under the judicially created doctrine of double patenting over claims 1-47 of U. S. Patent No. 6,618,993 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a railroad grade crossing assembly having a stanchion, a gate movable between a horizontal blocking position to an upright position to permit access, and a telescopic arm which extends between a blocking and unblocking position, and a programmable means to control the assembly.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr in view of Bertieri et al. Carr discloses a crossing assembly comprising a gate means (15) connectable to a stanchion (14 and 16) and movable between a generally upright position to permit access therethrough, and a controller (38) for controlling the function

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and operation of the door. Carr fails to disclose a programmable controller using relays and wireless links. Bertieri et al. disclose a controller using relays and wireless remote control links to program and operate a movable closure. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the assembly of Carr with a programmable controller as taught by Bertieri et al. since a programmable controller allows one to change and operate the function of a closure from a remote location.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carr and Bertieri et al. as applied to claim 1 above, and further in view of Keeling et al. All of the elements of the instant invention are discussed in detail above except providing a camera. Keeling et al. disclose a camera (38) to monitor the movement of traffic through a gate crossing. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the assembly of Carr with a camera as taught by Keeling et al. since a camera allows one to monitor areas of traffic and more particularly, traffic which could be recorded and/or monitored on a real time basis due to terrorists.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr and Bertieri et al. as applied to claim 1 above, and further in view of Fox or Loban et al. All of the elements of the instant invention are discussed in detail above except providing lights that are bulletproof. Fox discloses "bulletproof" lights (38, depending on

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what type of bullet and specifically how the applicant defines "bulletproof", the lights of Fox are durable and rigidly attached). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the gate means of Carr with "bulletproof" lights as taught by Fox since the lights of Fox provide durability in harsh environments as well as providing a signal that extends along the gate means. Loban et al. disclose a "bulletproof" lighting assembly. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the gate means of Carr with a "bulletproof" lighting assembly as taught by Loban et al. since a "bulletproof" lighting assembly provides durability in harsh environments as well as a light system for lighting up the gate means.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. patent to Parsadayan et al. disclose an extendable gate assembly similar to that of the applicant's invention. U.S. patent to Meyvis discloses a programmable controller for a closure similar to that of the applicant's invention. U.S. patent to Welk discloses a gate assembly similar to that of the applicant's invention. U.S. patent to Hopkins discloses a gate assembly, which has a portion, which rotates out of the throughway similar to that of the applicant's invention. U.S. patent to Fitzgibbon et al. disclose a programmable closure assembly similar to that of the applicant's invention.

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Any inquiry concerning this communication should be directed to Jerry Redman
at telephone number 571-272-6835.

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a horizontal line and a small upward flick.